

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

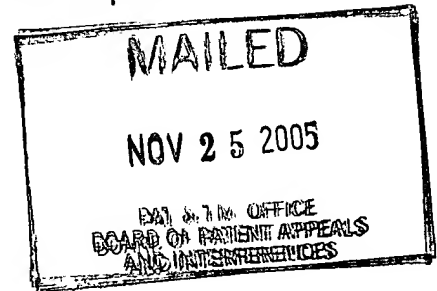
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Keith Rose, Karin Riley, and Coreen Kaplan

Appeal No. 2005-1696
Application No. 09/502,313

ON BRIEF



Before DIXON, BARRY, and NAPPI, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

A patent examiner rejected 1-16. The appellants appeal therefrom¹ under 35 U.S.C. § 134(a). We affirm.

I. BACKGROUND

The invention at issue on appeal concerns investing via the Internet. "Mutual funds" allow persons to invest in a basket of securities selected by a fund manager. When a mutual fund is operating, its share price fluctuates with the prices of its constituent securities. (Spec. at 1.)

¹The appellants' assertion that only "[c]laims 1-15 remain in the application," (Appeal Br. at 2), is at odds with the existence of claim 16.

Before a mutual fund begins operating, investors may be allowed to "subscribe" to the fund. To subscribe, an investor commits a certain amount of money to the fund or commits to buying a certain number of shares in the fund before the fund begins operating. The period during which such commitments are allowed is called the "subscription period." When the fund begins operating at the end of the subscription period, the investors buy shares of the fund at its opening price. (*Id.* at 2.)

Conventional securities brokers have salesmen who solicit such subscriptions via telephone calls or direct mailings. Investors subscribe over the telephone or by using a reply card received with the direct mail materials, respectively. (*Id.*) Because the response rate of such a solicitations is relatively low, explain the appellants, the cost of such solicitations is "prohibitively expensive." (*Id.* at 3.)

In contrast, the appellants' invention posts a notice of a subscription offering on the home page of a web site. The notice includes a link capable of directing a user to a web page on which he may subscribe to the associated mutual fund. A summary of the amount of the user's subscription is recorded and transmitted to the mutual fund management. Because the notice is provided on a home page, assert the appellants, the notice is less intrusive than a telephone call or direct mailing. Because following the link will take the user to a application which can be used to subscribe to the fund with a

minimum of effort, add the appellants, users may be more likely to subscribe to the fund than if they had received a mailing. (*Id.* at 5.)

A further understanding of the invention can be achieved by reading the following representative claim:

1. A method of receiving a subscription to a mutual fund, the method comprising:

receiving a request for a home page;

providing the home page comprising a notice of a subscription offering and a link to a web page;

receiving a request for the web page;

providing web page information allowing a user to subscribe to the mutual fund responsive to the receiving the request for the web page; and

receiving an indication of an amount of money to be invested in the mutual fund.

Claims 1-16 stand rejected under 35 U.S.C. § 103(a) as obvious over two published patent applications: U.S. Patent Application Publ. No. 2003/0135457 A1 ("Stewart") and U.S. Patent Application Publ. No. 2001/00346410 A1 ("D'Amico"). (Final Rej. at 2.)

II. OPINION

"[T]o assure separate review by the Board of individual claims within each group of claims subject to a common ground of rejection, an appellant's brief to the Board must contain a clear statement for each rejection: (a) asserting that the patentability of claims within the group of claims subject to this rejection do not stand or fall together, and (b) identifying which individual claim or claims within the group are separately patentable and the reasons why the examiner's rejection should not be sustained." *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (citing 37 C.F.R. §1.192(c)(7) (2001)). "If the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim." *Id.*, 63 USPQ2d at 1465.

Here, the appellants stipulate that all "[t]he claims stand or fall together." (Appeal Br. at 6.) We select claim 1 as representative thereof.

With this representation in mind, rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the point of contention therebetween. The examiner finds that Stewart "provid[es] online financial account services comprising receiving a subscription to open and fund a new deposit account online through a web

site of a financial institution 10. The customer 20 is directed to the web site of the financial institution by web-based advertising or other links, by a web search engine or by directly entering the site's URL address in a web browser." (Examiner's Answer at 4-5.) He further finds that D'Amico "disclose[s] prospective customers purchasing shares of a mutual fund by contacting the mutual fund on the Internet, requesting an application and then submitting the completed application along with the appropriate funds to the fund advisor (see page 3, paragraph (0047))." (*Id.*) The examiner concludes, "It would have been obvious . . . in view of the teachings in D'Amico . . . to allow a customer of [Stewart] to both open and fund a mutual fund account over the Internet, thereby expanding the customers investment options and enabling the customer to buy and sell mutual fund shares online. (*Id.*)

The appellants contest neither the examiner's aforementioned findings nor his aforementioned conclusion. Instead, they argue, "The cited portions of Stewart . . . do not find support in its provisional applications. 60/168273 contains a short summary that does not teach someone skilled in the art how to make and use the invention. . . ." (Reply Br. at 2.) They further argue that "there is no support meeting the standards of 35 U.S.C. 112 in D'Amico's provisional application for paragraph 0047 on page 3 of the published application." (*Id.*)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the representative claim at issue to determine its scope. Second, we determine whether the construed claim would have been obvious.

A. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — what is the invention claimed?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, claim 1 recites in pertinent part the following limitations:

receiving a request for a home page;

providing the home page comprising a notice of a subscription offering and a link to a web page;

receiving a request for the web page;

providing web page information allowing a user to subscribe to the mutual fund responsive to the receiving the request for the web page; and

receiving an indication of an amount of money to be invested in the mutual fund.

Giving the representative claim its broadest, reasonable construction, the limitations require advertising a mutual fund on a first web page and, upon a user's selection of a link on the first web page, allowing the user to buy the fund via a second web page wherein the user can indicate an amount of money to be invested in the fund.

B. OBVIOUSNESS DETERMINATION

Provisional patent applications are authorized by 35 U.S.C. §111(b). More specifically, "[s]uch [an] application shall include . . . a specification as prescribed by the first paragraph of section 112 of this title. . . ." 35 U.S.C. §111(b)(1)(A). For its part, 35 U.S.C. §112, ¶ 1, imposes the following requirements.

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as **to enable any person skilled in the art** to which it pertains, or with which it is most nearly connected, **to make and use the same**, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

(Emphases added.)

"The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *U.S. v. Telectronics, Inc.*, 857 F.2d 778, 785,

8 USPQ2d 1217, 1223 (Fed. Cir. 1988) (citing *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed.Cir.1986)). "Title 35 requires only that the inventor enable one of skill in the art to make and use the full scope of the claimed invention," *CFMT Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1338, 68 USPQ2d 1940, 1944 (Fed. Cir. 2003); "[t]hus, the level of disclosure necessary to satisfy section 112 of title 35 varies according to the scope of the claimed invention." *Id.*, 68 USPQ 2d at 1944 (citing *Durel Corp. v. Osram Sylvania Inc.*, 256 F.3d 1298, 1306-07 (Fed. Cir. 2001); *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993); *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988)).

As aforementioned, the appellants do not contest that the combined teachings of Stewart and D'Amico would have suggested their representative claim. Instead, they argue that the provisional patent applications on which Stewart and D'Amico rely for an effective filing date would not have enabled the claim. (Reply Br. at 2.) More specifically, Stewart is related to U.S. Provisional Patent Application No. 60/168,273 ("the '273 Application") and U.S. Provisional Patent Application No. 60/168,276 ("the '276 Application"). Similarly, D'Amico is related to U.S. Provisional Patent Application No. 60/181,580 ("the '580 Application").

The '273 Application discloses "[a] fully-integrated and substantially-automated system and method for providing wholly-integrated account services over the Internet by which a consumer can establish a financial account electronically, without physically visiting the financial institution, and a system for effecting the method." P. 6. The '273 Application explains that its system and method were implemented using the existing "QualiFile and SecureCheck products. . . ." § 2.1. Furthermore, the IAS Process Flow Diagram in the '273 Application shows that the known technologies of the Internet, Hypertext Markup Language ("HTML"), Common Gateway Interface ("CGI") scripts, eXtensible Markup Language ("XML"), and the JAVA programming language were also used for the implementation.

Initially, the '273 Application uses "[t]he Internet . . . to attract potential customers to the financial institution's [web] site, where the potential customers can learn about the products offered by the financial institution." P. 2. For its part, the '590 Application evidences that mutual funds were advertised via web pages. Pp. 2 and 9-10. Based on these disclosures, we conclude that one reasonably skilled in the art could have advertised a mutual fund on a first web page without undue experimentation.

The '273 Application also permits a "potential customer [to] appl[y] on-line, providing personal information to the financial institution such as is necessary to determine whether or for which products the customer will be approved." P. 2. For its part, the '580 Application shows that "Applications" were accessed on-line by selecting a link on a first web page. P. 9. Regarding information that was known in the art, furthermore, the appellants admit that at the time of their invention "[m]any investors use online brokerage services." (Spec. at 3.) Such online brokerage services "allow[ed] an investor to subscribe to a mutual fund before its operation by filling in one or more online forms using a browser on a personal computer coupled to the Internet. The information [was] returned to the online brokerage using conventional CGI techniques." (*Id.*) Based on these teachings and knowledge, we conclude that one reasonably skilled in the art could have enabled a user to subscribe to a mutual fund by selecting a link to a second web page.

The '273 Application "also provides a method for automated funding of the account products chosen by the customer and for fulfillment support of the account products." P. 2. More specifically, funding was implemented via the aforementioned SecureCheck product. Deluxe Corp, § 2.1. Based on these teachings, we conclude that one reasonably skilled in the art could have enabled a user to indicate an amount of money to be invested in a fund.

Because the provisional patent applications would have enabled the claim, we are persuaded that Stewart and D'Amico are entitled to the filing dates of these applications. (Reply Br. at 2.) As aforementioned, the appellants do not contest that the combined teachings of Stewart and D'Amico would have suggested their representative claim. Therefore, we affirm the obviousness rejection of claim 1 and of claims 2-16, which fall therewith.

III. CONCLUSION

In summary, the rejection of claims 1-16 under § 103(a) is affirmed. "Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences. . . ." 37 C.F.R. § 1.192(a). Accordingly, our affirmance is based only on the arguments made in the briefs. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

JOSEPH L. DIXON
Administrative Patent Judge

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~~ROBERT NAPPI~~
Administrative Patent Judge

Appeal No. 2005-1696
Application No. 09/502,313

Page 13

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